

REMARKS

Status of the Claims:

Claims 1 – 3, 5 – 10 and 76 – 80 are currently pending.

Claims 4 and 11 – 75 are cancelled.

Claims 8, 77 and 80 are objected to.

Claims 1, 7 – 9 and 76 – 80 are currently amended.

Amendments to the Claims:

No new matter has been introduced by way of the claim amendments.

Rejected Claims:

Independent claim 1 is presently amended to incorporate a surfactant as a claimed element. Support for this amendment may be found in at least original claim 8 and paragraphs [0009], [0016] and [0040] of the instant specification. Other amendments to claim 1 have been made to correct minor grammatical errors.

Claim 7 is presently amended to depend from claim 1, instead of from claim 3. Support for this amendment may be found in at least paragraph [0042] of the instant specification.

Claim 9 is presently amended to depend from claim 1, instead of from claim 3. Support for this amendment may be found in at least paragraph [0052] of the instant specification.

Claim 76 is presently amended for antecedent purposes.

Claim 78 is presently amended to depend from claim 1, instead of from claim 3. Support for this amendment may be found in at least paragraph [0040] of the instant specification.

Claim 79 is presently amended to depend from claim 1, instead of from claim 3. Support for this amendment may be found in at least paragraph [0039] of the instant specification.

Claims Objected To:

Claim 8 has been rewritten into independent form, including all of the limitations of previous claims 1, 3, 7 and 8.

Claim 77 has been rewritten into independent form, including all of the limitations of previous claims 1 and 77.

Claim 80 has been rewritten into independent form, including all of the limitations of previous claims 1, 3 and 80.

I. Claims Rejected Under 35 U.S.C. § 102

Claims 1 – 3, 5 – 7, 9, 10, 76, 78 and 79 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent 7,501,108 (hereinafter, '*108*'). Office Action page 2. Applicants respectfully traverse the rejection of these claims in view of the claim amendments and remarks presented herein.

I.1 Standard of Review

The standard of review for establishing anticipation under 35 U.S.C. § 102 is set forth as follows: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP § 2131.

I.2 Examiner's Grounds for Rejection

The Examiner asserts that '*102* teaches a printable composition of polymer-coated single-wall carbon nanotubes dispersed in water. The Examiner asserts that the nanotubes have a diameter of 2 – 3 nm. The Examiner asserts that '*102* teaches a chemically-derived essentially homogenous population, homogenization and separation with respect to dimension, and binders. The Examiner alleges that the taught nanotubes are inherently fluorescent and emit light in the near infrared wavelength range and that the emission is tunable. The Examiner alleges that since the taught composition is printable, it can be deposited on a surface in patterned form.

I.3 Applicants' Characterization of '102

Stable aqueous suspensions of dispersed, essentially single, carbon nanotubes are taught by '102 (see '102, Abstract). The stable aqueous suspensions include a water-soluble polymer (see '102, Abstract). The polymer adsorbs on the carbon nanotubes and prevents their aggregation (see '102, Col. 2, lines 49 – 50). '102 expressly teaches that surfactants do not form the taught stable aqueous suspensions (see '102, Col. 4, lines 13 – 27).

I.4 Claims 1 – 3, 5 – 7, 9, 10, 76, 78 and 79 Are Not Anticipated by '102

Applicants respectfully assert that claim 1, as this claim presently stands amended, is not anticipated by '102, since the cited reference does not teach, either expressly or inherently, fluorescent inks containing dispersed carbon nanotubes and a surfactant. The taught stable aqueous suspensions of '102 include a polymer, not a surfactant. Furthermore, '102 expressly teaches that surfactants do not lead to dispersed carbon nanotubes in a solvent. Hence, the fluorescent ink of claim 1 is not taught by '102.

In view of the foregoing, Applicants respectfully assert that claim 1, as presently amended, is not anticipated by '102, since the cited reference does not teach all of the claim limitations. Claims 2, 3, 5 – 7, 9, 10, 76, 78 and 79 depend either directly or indirectly from patentable claim 1 and are not anticipated for at least the same reasons. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Therefore, Applicants respectfully request that the Examiner's rejection of claims 1 – 3, 5 – 7, 9, 10, 76, 78 and 79 under 35 U.S.C. § 102(c) be withdrawn.

II. Claims Objected To

Claims 8, 77 and 80 are presently objected to as being dependent from a rejected base claim. However, the Examiner has stated that these claims would be allowable if rewritten into independent form, including all of the limitations of the base claim and any intervening claims. Office Action page 3.

Applicants have amended the claims as follows: Claim 8 is amended to include all of the limitations of claims 1, 3, 7 and 8. Claim 77 is amended to include all of the limitations of

claims 1 and 77. Claim 80 is amended to include all of the limitations of claims 1, 3 and 80. In view of the amendments, Applicants respectfully assert that claims 8, 77 and 80 are now allowable for at least the reasons set forth in the Office Action.

CONCLUSIONS

Claims 1 - 3, 5 - 10 and 76 - 80 remain pending in the Application. Applicants respectfully assert that claims 1 - 3, 5 - 10 and 76 - 80, as these claims presently stand amended, are now in a condition for allowance based on the remarks presented hereinabove.

If additional fees are due and are not included, the Director is hereby authorized to charge any fees or credit any overpayment to Deposit Account Number 23-2426 of Winstead PC (referencing matter 11321-P075WOUS).

If the Examiner has any questions or comments concerning this paper or the present application in general, the Examiner is invited to call the undersigned at 713-650-2663.

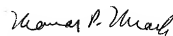
Respectfully submitted,

WINSTEAD PC

Attorney/Agent for Applicants

Date: September 8, 2009

By:


Thomas P. Thrash, Reg. No. 64,805
Robert C. Shaddox, Reg. No. 34,011

P. O. Box 50784
Dallas, Texas 75201
Tel: 713.650.2663
Fax: 214.745.5390